

### **REMARKS**

Claims 1-20 are pending in the Application. Claims 15-20 have been added. The Specification has been amended to correct typographical errors. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

A priority statement has been added to the Specification as requested by the Examiner. Claims 2 and 4 have not been amended to include additional features, but rewritten in independent form.

### **The 35 U.S.C. § 103 Rejections**

For brevity the Applicants have not necessarily presented all the reasons as to why the applied reference does not render the claims obvious. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments show that the applied reference does not disclose or suggest all of the steps, features, and relationships of the claimed invention. Hence, Applicants' claims patentably distinguish over the applied reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

### **The Legal Standard**

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish *prima facie obviousness*, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

#### **The U.S. Bancorp Article**

The U.S. Bancorp article is directed to the desirability of PC home banking. The article refers to the "project", "development", "vision", and how it "aspires" to make banking "available in the home through the PC."

The detail-deficit information provided in the U.S. Bancorp article can be likened to space travel history. The desire for space travel was dreamed of for many decades while it lacked the necessary information to actually reduce it to practice. The U.S. Bancorp article corresponds to the infant dream state of PC home banking. For example, the document states that "it aspires to make a full-service branch available in the home through the PC" and "The vision is that the customer would be able to do everything on-line that they can now do in a branch." Part of this aspiration (i.e., dream) would be to "download cash and make deposits." However, the document does not explain how a home PC could enable the PC user to dispense a currency note (receive

cash bills from the PC), or deposit a currency note (deposit cash bills into the PC), or cash a check (receive cash bills from the PC). That is, the dream of the article's PC home banking capabilities are far from the real available transaction capabilities easily performed at a bank branch. The article at best appears limited to suggesting that home PC users could make transfers (e.g., download cash and make deposits) between accounts and use "a live teller through two-way full-motion video."

**The Pending Claims Are Not Obvious Over  
U.S. Bancorp**

In the Action claims 1-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the article "U.S. Bancorp, Microsoft Paving New Roads to On-line Banking" (hereinafter "U.S. Bancorp"). These rejections are respectfully traversed. Applicants' remarks concerning the claim rejections in no way waive their rights to have the rejections relying on the U.S. Bancorp reference stricken for the reasons presented herein.

**The U.S. Bancorp Article Does Not Constitute Prior Art**

Applicants traverse the allegation that the U.S. Bancorp article is a legitimate prior art document. Applicants question the accuracy of the date and subject matter of the apparently electronic document. Applicants request evidence of the validity of this document. Applicants request a non-electronic copy version of this allegedly published U.S. Bancorp article.

The Office has presented no proof that an electronic document version of the U.S. Bancorp article was accessible to members of the public prior to Applicants' filing date.

Applicants challenge the alleged creation (and/or alleged publicly accessible) date of the electronic document as a prior art date. Nor has the Office shown that the information relied upon in the electronic document version is identical to an earlier-published (prior art) non-electronic copy version. Therefore, the relied upon U.S. Bancorp article does not constitute a printed publication nor prior art. Applicants respectfully request that the rejections be withdrawn on this basis.

### **The 35 U.S.C. § 103 Rejections Are Traversed**

Applicants traverse these rejections on the grounds that Applicants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied reference.

As noted above, the U.S. Bancorp article does not constitute prior art. Nevertheless, even if it were somehow possible for the U.S. Bancorp article to constitute prior art, it still would not have been obvious to have modified the U.S. Bancorp article to have produced the claimed invention.

The Action admits that U.S. Bancorp fails to disclose or suggest that a "customer's automated banking machine PC has a sheet dispenser mechanism operatively responsive to receipt of at least one HTML format document by the browser, so as to dispense an output through an output device of the automated banking machine PC, or that the U.S. Bancorp system can be used in an ATM machine to remotely access the on-line bank." That is the Action admits that U.S. Bancorp lacks:

- 1.) an automated banking machine having a sheet dispenser mechanism operatively responsive to receipt of a document by a browser.
- 2.) an automated banking machine that is able to provide an output through an output device of the automated banking machine based on receipt of a document by a browser.
- 3.) use in an ATM machine to remotely access an on-line bank.

Applicants agree that U.S. Bancorp is deficient in the features for which it is relied upon. Applicants respectfully submit that U.S. Bancorp lacks many other recited features and relationships.

The Action asserts official notice concerning several features. Applicants respectfully traverse the official notice assertions on the basis that they are not supported by any reference to prior art. The Office is not permitted to rely merely on assertions of "official notice" as the basis for rejecting claims. Furthermore, when challenged the Office is required to establish such assertions in the proper manner through citation to prior art. Applicants challenge all rejections based upon alleged "official notice." Compliance by the Office with MPEP § 2144.03 is respectfully requested.

### **Claim 1**

Claim 1 recites a currency sheet dispenser.

Applicants challenge the rationale that "HTML web pages controlling the functioning of any and all of the myriad of banking functions of the US BANKER PC including the function of providing output through an output device and dispensing of at least one sheet or note from a printer associated with the PC" was well known.

Applicants challenge the rationale that a PC printer could constitute a currency sheet dispenser. Applicants request prior art evidence of dispensing a currency note from a PC printer. Otherwise, the rejection is without basis. Where does U.S. Bancorp teach that a PC is able to dispense a currency sheet? U.S. Bancorp is not capable of printing (counterfeiting) currency notes by a PC, which (if possible) would have been illegal. Nor would such an action have been obvious to one having ordinary skill in the art. It follows that U.S. Bancorp's home banking PC cannot constitute the recited automated transaction machine. Nor can a PC printer constitute the recited currency sheet dispenser.

Applicants also challenge the rationale that using a PC in "providing output through an output device and dispensing of at least one sheet or note from a printer associated with the PC" was well known. The Action admits that U.S. Bancorp lacks an automated banking machine that is able to dispense an output through an output device of the automated banking machine based on receipt of a document by a browser. Applicants request prior art evidence of a PC that was able to provide an output through an output device responsive to a document accessed by a browser during operation of the printer. That is, the evidence must show that the output is related to the accessed document, and that the output is through an output device during operation of the printer. Compliance by the Office with MPEP § 2144.03 is respectfully requested. Nor has the Action explained how U.S. Bancorp could have been modified to have included the recited features and relationships. Nor would it have been obvious to have modified U.S. Bancorp to have produced the recited invention.

Applicants also request evidence of "web pages controlling" the banking functions of a PC. Applicants request prior art evidence of web pages "controlling" the dispense of "at least

one sheet or note from a printer associated with the PC." U.S. Bancorp does not disclose or suggest such features. Applicants further request evidence of an automated transaction machine that is able to provide an output through an output device responsive to a document accessed by a browser, and during operation of a currency sheet dispenser. Furthermore, it would not have been obvious for a user of a home PC to release control of their PC to outside web pages.

Furthermore, even if it were somehow possible for U.S. Bancorp to have an output responsive to receipt of at least one document (which U.S. Bancorp doesn't), then there would still be no indication that the output would occur during operation of a currency sheet dispenser. That is, a modified U.S. Bancorp would still not disclose or suggest an automated transaction machine involving a document, output device, and currency sheet dispenser relationship in the manner recited. Thus, it would not have been obvious to have modified U.S. Bancorp to have produced the claimed invention.

Additionally, the Action admits that U.S. Bancorp lacks use "in an ATM machine to remotely access the on-line bank." The Action alleges that it would have been obvious to use the system of U.S. Bancorp in "a regular ATM machine rather than a home PC, so as to increase on-line banking access to the citizens that did not have a home PC."

The Applicants disagree. The Action is silent as to how the system of U.S. Bancorp could be operationally included in "a regular ATM machine." As previously discussed, the system of U.S. Bancorp (even if modified as alleged) would not teach the recited features and relationships. Thus, nor would the system of U.S. Bancorp if somehow placed in "a regular ATM machine" teach the recited features and relationships. Furthermore, there would be no motivation for a citizen to use the alleged modified ATM (having the system of U.S. Bancorp)

when they could use a full service branch or even a regular ATM. There is no indication that the alleged modified ATM would be able to serve citizens any better or have more availability than a full service branch. Furthermore, PC home banking is based on convenience. There is no indication in U.S. Bancorp that convenience would be increased by leaving the home PC environment. Contrarily, the entire U.S. Bancorp article is directed to using the home PC. Thus, the Action's allegation of using the system of U.S. Bancorp in a regular ATM machine, which would be remote from the PC user's home, goes directly against the teaching of U.S. Bancorp.

A reference teaching away from the recited invention does not support prima facie obviousness. Also, an obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). As the combination of features asserted in the Action would destroy the utility and advantages of the U.S. Bancorp reference, it is respectfully submitted that the rejection is improper and should be withdrawn. Additionally, the only suggestion for having the alleged ATM of the Action is found in Applicants' own novel disclosure. It follows that the alleged modification of U.S. Bancorp (and the rejection) is based on hindsight reconstruction of the recited invention based on Applicants' disclosure, which is impermissible. Therefore, it would not have been obvious to one having ordinary skill in the art to have modified U.S. Bancorp to have produced the claimed invention.

## **Claim 2**

Claim 2 recites that a browser-accessed document includes instructions which are operative to provide the output through the output device and cause the computer to operate the sheet dispenser. Furthermore, the software is operative to provide the output during operation of



the sheet dispenser. The Action is silent as to the recited features. U.S. Bancorp does not disclose or suggest the recited software or machine. Nor would it have been obvious to have modified U.S. Bancorp to have produced the recited invention.

### **Claim 3**

Claim 3 refers to the document comprising an HTML document. The document, which is accessible by a browser, relates to providing an output through an output device during operation of a currency sheet dispenser. U.S. Bancorp does not disclose or suggest using an HTML document in the manner recited.

### **Claim 4**

Claim 4 recites that a machine is operative responsive to processing a dispense document to operate a sheet dispenser responsive to a dispense instruction and access the first document responsive to the dispense instruction. U.S. Bancorp does not disclose or suggest processing a dispense document including a dispense instruction and then accessing another document responsive to the dispense instruction.

The Action (e.g., page 5) alleges that a modified U.S. Bancorp would have "web pages including dispense instructions embedded therein so as to control the sheet dispenser and the output of sheets or notes." The Applicants disagree. The Action has provided no prior art evidence of an accessed web document having instructions therein for controlling a sheet dispenser. Nor has the Action shown a computer operative to operate a sheet dispenser responsive to a dispense document's dispense instruction.

#### **Claim 5**

The Action is silent as to the recited features. U.S. Bancorp does not disclose or suggest that a computer is operative responsive to processing an additional device document to operate an additional transaction function device and is operative to access a second document responsive to the additional device document.

#### **Claim 6**

Claim 6 recites that a dispense document includes a first document access instruction, and that the browser is capable to process the first document responsive to the first document access instruction. The Action is silent as to the recited features. U.S. Bancorp does not disclose or suggest the recited relationship between a dispense document and a first document.

#### **Claim 7**

U.S. Bancorp does not disclose or suggest accessing a transaction device operation document with a browser in an automated transaction machine. Where does U.S. Bancorp even discuss a transaction device operation document? U.S. Bancorp does not relate operating a transaction device with the processing of a transaction device operation document. Nor does U.S. Bancorp relate outputting an output with the processing of the transaction device operation document. It follows that U.S. Bancorp cannot disclose or suggest automatically operating or automatically outputting responsive to processing the transaction device operation document.

#### **Claim 8**

The Action is silent as to the recited step. U.S. Bancorp does not disclose or suggest accessing a first document responsive to processing a transaction device operation document, and an output is generated responsive to processing the first document.

**Claim 9**

The Action is silent as to the recited steps. U.S. Bancorp does not disclose or suggest a first transaction function device and a second transaction function device. Nor does U.S. Bancorp disclose or suggest that a transaction device operation document is operative to cause the operation of the first transaction function device. Nor does U.S. Bancorp disclose or suggest operating the second transaction function device in the machine responsive to accessing a further transaction machine document. Nor does U.S. Bancorp disclose or suggest accessing a second document responsive to receipt of the further transaction machine operation document, and outputting a further output.

**Claim 10**

The Action is silent on outputting a promotional message. U.S. Bancorp does not disclose or suggest an output including a promotional message.

**Claim 11**

The Action is silent on outputting promotional messages. U.S. Bancorp does not disclose or suggest an output including a promotional message and a further output including a second promotional message.

**Claim 12**

The Action is silent as to the recited steps. U.S. Bancorp does not disclose or suggest determining an address of a first document to access responsive to user data inputted in the manner recited.

### **Claim 13**

U.S. Bancorp does not disclose or suggest that between at least two consecutive transaction steps a device in an automated transaction machine automatically operates in response to an accessed document. Nor does U.S. Bancorp disclose or suggest automatically providing an output through an output device on the machine responsive to an accessed document during at least a portion of the device operation.

### **Claim 14**

The Action is silent as to the recited steps. U.S. Bancorp does not disclose or suggest a request to dispense a currency sheet. Nor is an output provided during at least a portion of the time a currency sheet dispenser device operates.

### **The Official Notices**

Applicants disagree with and challenge the "official notice" basis for rejections. Applicants also disagree with the Action's "official notice that the limitations of claims 7-14 do not define anything new over that which was known to one of ordinary skill in the art of web browser software and networking at the time that the invention was made." Especially in view of the Action's reliance on many features that are admittedly absent in U.S. Bancorp. Also, if the recited features were so well known and not "new" then where is the anticipating prior art and why is an obvious type of rejection required?

Applicants challenge all "official notice" allegations. If the recited features were related to "facts outside of the record which are capable of instant and unquestionable demonstration" (MPEP 2144.03) then why haven't these "facts" been clearly evidenced? That is, if Applicants'

recited features were so instantly and readily available, then why haven't they been revealed and applied? Additionally, the lack of referenced pertinent prior art, in view of the Office's vast resources of prior art search capabilities, is taken by Applicants as an admission by the Office that the asserted "official notice" features do not exist as prior art.

Furthermore, even if it were somehow possible to show the admittedly absent features as well known, then it still would not have been obvious to one having ordinary skill in the art to have modified U.S. Bancorp to have produced the recited invention. Nor would it have been obvious to have modified U.S. Bancorp with the alleged teachings of the official notices. Nor has any evidence been presented that U.S. Bancorp is structurally and functionally capable of including the features and relationships in the manner recited. The Action is also silent as to how the recited features could be included in U.S. Bancorp in the manner recited. Nor would it have been obvious to have provided U.S. Bancorp with the recited features and relationships as alleged. Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art. Nor has any teaching, suggestion, or motivation been cited so as to produce Applicants' invention.

The Office is reminded that in accordance with MPEP 2144.03, any "official notice" reference added as evidence of a prior assertion is limited to proof of the "well known" prior statement in the Action, and the Office cannot rely on any other teachings in the reference. Therefore, any added reference is strictly limited to a specific showing of features alleged as well known. Any reliance on another teaching in the reference would constitute a new ground of rejection.

### **U.S. Bankcorp is Not Prior Art**

Even if the Office could show that U.S. Bankcorp is entitled to a 2/96 date as a reference (which it hasn't), U.S. Bankcorp would still not constitute prior art. Applicants reduced their invention to practice prior to such date. However, as the Office has failed to present a legally proper rejection against any pending claims, Applicants need not swear behind the purported date of U.S. Bankcorp to establish that all the pending claims are allowable.

### **Fees For Additional Claims**

Please charge the fees associated with the submission of two (2) additional independent claim (\$160) and any other fee due to deposit account 09-0428.

## **Versions With Markings To Show Changes Made**

### **In the Specification**

Paragraph beginning on Specification page 23, line 6 and ending on Specification page 23, line 13:

Returning to the sample transaction, in response to receiving the enable card reader message from the device application portion 84, the device server 92 is operative to generate a message through the intranet 16 to the device interfacing software portion 64 of the ATM 12. This message which comprises an HTTP record including instructions for operating the card reader, is directed to the IP port indicated 74 which is where the device interfacing software portion 64 communicates. In response to receiving this message, the software portion 64 is operative to send a message or messages on the control bus 50 which enables card reader mechanism 38 [34].

Paragraph beginning on Specification page 23, line 14 and ending on Specification page 24, line 2:

Continuing with the transaction as shown in Figure 6, the input of the card by the customer to the card reader 38 [34] is operative to cause the card data to be read and the device interfacing program portion 64 to send a message to the device server 92 indicating the card data has been read. This message is transmitted by the device server through the intranet 16 to the

device application portion 84. The device application portion then sends a message to the device server requesting the card data. The device server 92 transmits a message with instructions to deliver the card data from the device interfacing software portion 64 which responds with a message sending the card data through the intranet to the device server. The device server, if there is no basis for stopping the transaction, transmits an HTTP record including card data back through the intranet 16 to the device application portion 84.

Paragraph beginning on Specification page 70, line 10 and ending on Specification page 70, line 16:

Figures 28-30 include schematic depictions of examples of the operation of the keyboard mapper and the keypad applet. Figure 27 [29] shows an example of an input to the keypad 168. In this example the keypad applet 170 generally in response to instructions in an HTTP record such as an HTML document or other events, transmits and enables events to the transaction services application 146. In response a mapset is selected from the database 176 corresponding to the particular map name. The keyboard command server is further operative to enable the appropriate keys of the ATM.

### **In the Claims**

1. (once amended) Apparatus comprising:

an automated transaction machine including:



an output device;

a currency sheet dispenser;

a computer in operative connection with the output device and the  
currency sheet dispenser; and

software executable in the computer, wherein the software includes a  
browser, and wherein during operation of the currency sheet dispenser the  
software is operative to provide an output through the output device  
responsive to a [first HTML] document accessed by the browser.

2. (once amended) Apparatus [The apparatus according to claim 1] comprising:

an automated transaction machine including:

an output device;

a sheet dispenser;

a computer in operative connection with the output device and the sheet  
dispenser;

software executable in the computer, wherein the software includes a browser, and wherein during operation of the sheet dispenser the software is operative to provide an output through the output device responsive to a first document accessed by the browser;

wherein the first document includes instructions which are operative when processed by the browser to provide the output through the output device, and to cause the computer to operate the sheet dispenser to dispense [of] a sheet.

3. (once amended) The apparatus according to claim 1 and further comprising:

at least one server;

a plurality of HTML documents accessible through the server, wherein the [first] document comprises a first HTML document and is accessible through the server; and

wherein the browser is operative to access the first HTML document through the server.

4. (once amended) Apparatus [The apparatus according to claim 3] comprising:

at least one server;

a plurality of documents accessible through the server, wherein a first document is accessible through the server;

an automated transaction machine including:

an output device;

a sheet dispenser;

a computer in operative connection with the output device and the sheet dispenser;

software executable in the computer, wherein the software includes a browser, wherein the browser is operative to access the first document through the server, and wherein during operation of the sheet dispenser the software is operative to provide an output through the output device responsive to the first document accessed by the browser;

wherein the documents accessible through the at least one server includes a dispense document including a dispense instruction, and wherein the computer is

operative responsive to processing the dispense document with the browser to operate the sheet dispenser responsive to the dispense instruction, and wherein the machine is operative to access the first document with the browser responsive to the dispense instruction.

7. (once amended) A method comprising the steps of:

accessing a transaction device operation document with a browser in an automated transaction machine, the transaction device operation document including at least one transaction device instruction;

automatically operating a transaction device in the machine responsive to processing the transaction device operation document with the browser; and

automatically outputting with an output device on the machine an output responsive to processing the transaction device operation document with the browser.

13. (once amended) A method comprising the steps of:

a) accessing at least one document with a browser in an automated transaction machine;

b) executing a series of transaction steps with an automated transaction machine wherein between at least two [of] consecutive transaction steps a device in the machine automatically operates in response to an accessed document;

[b) accessing an HTML document with a browser in the machine;]

c) automatically providing an output through an output device on the machine responsive to an accessed [the HTML] document during at least a portion of [while] the device operation [operates].

14. (once amended) The method according to claim 13 wherein step (b) [(a)] includes a transaction step including a request to dispense at least one currency sheet, wherein a currency sheet dispenser device operates responsive to the request transaction step, and wherein output in step (c) is provided during at least a portion of the time the currency sheet dispenser device operates.

### Conclusion

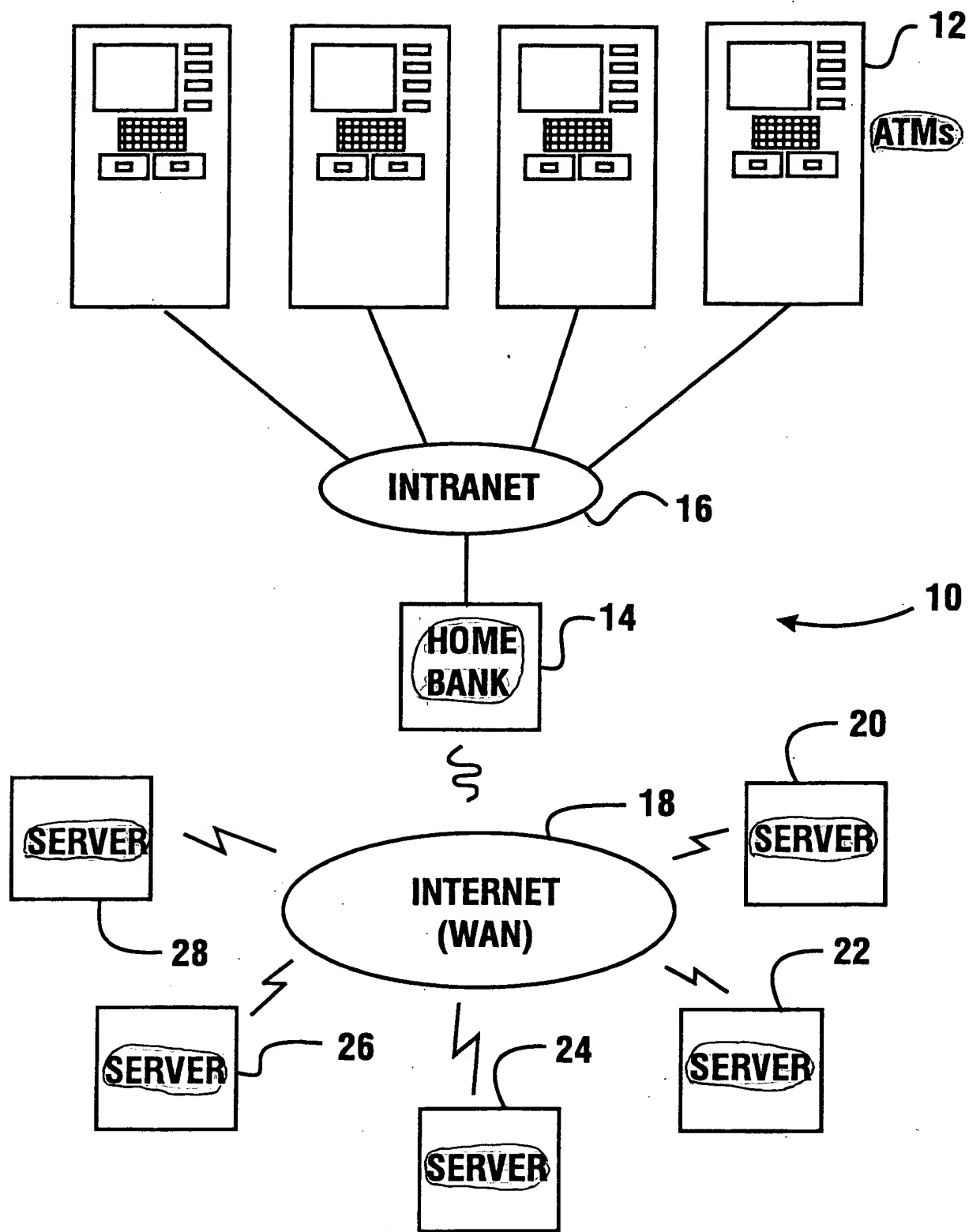
Each of Applicants' pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

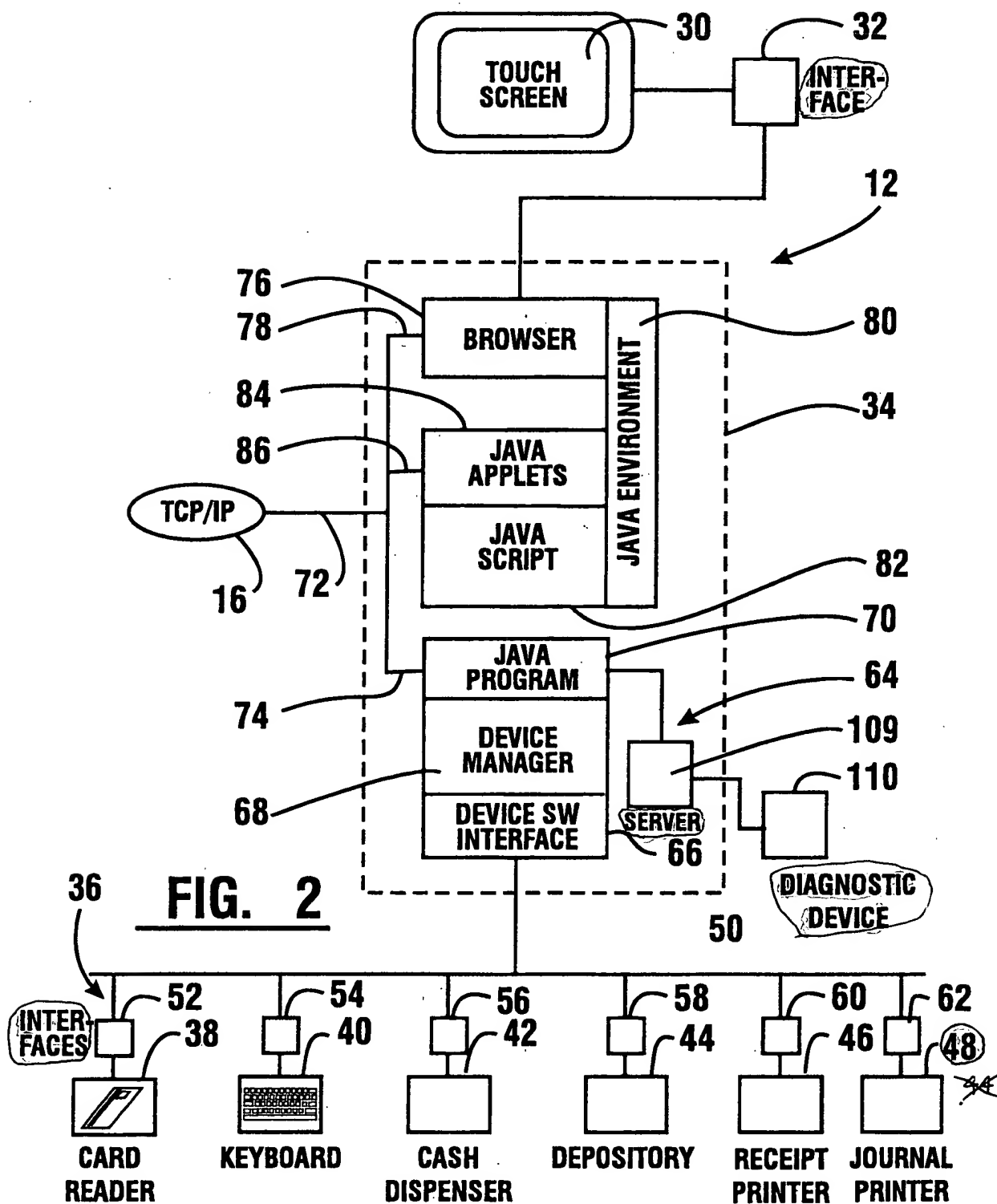
Respectfully submitted,



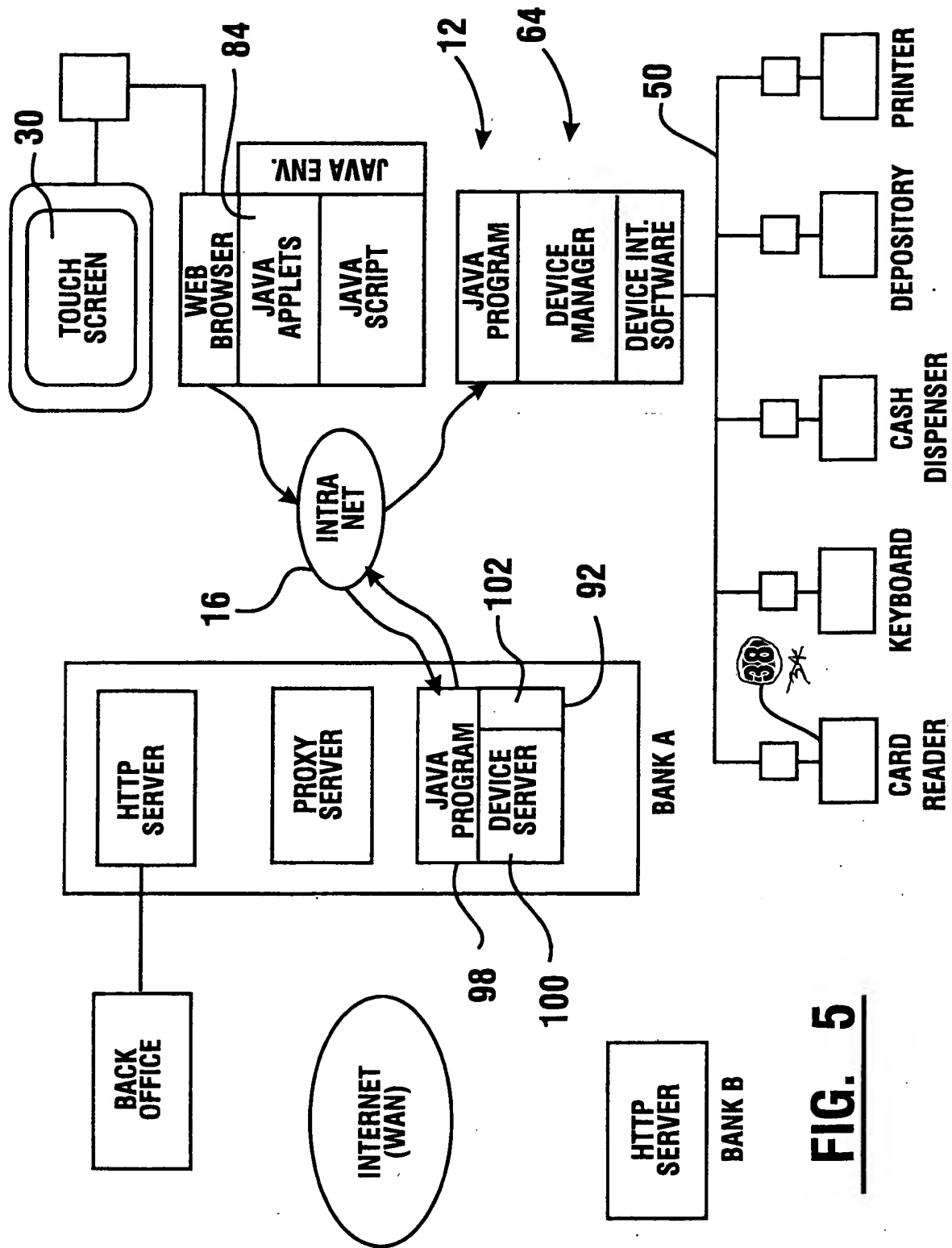
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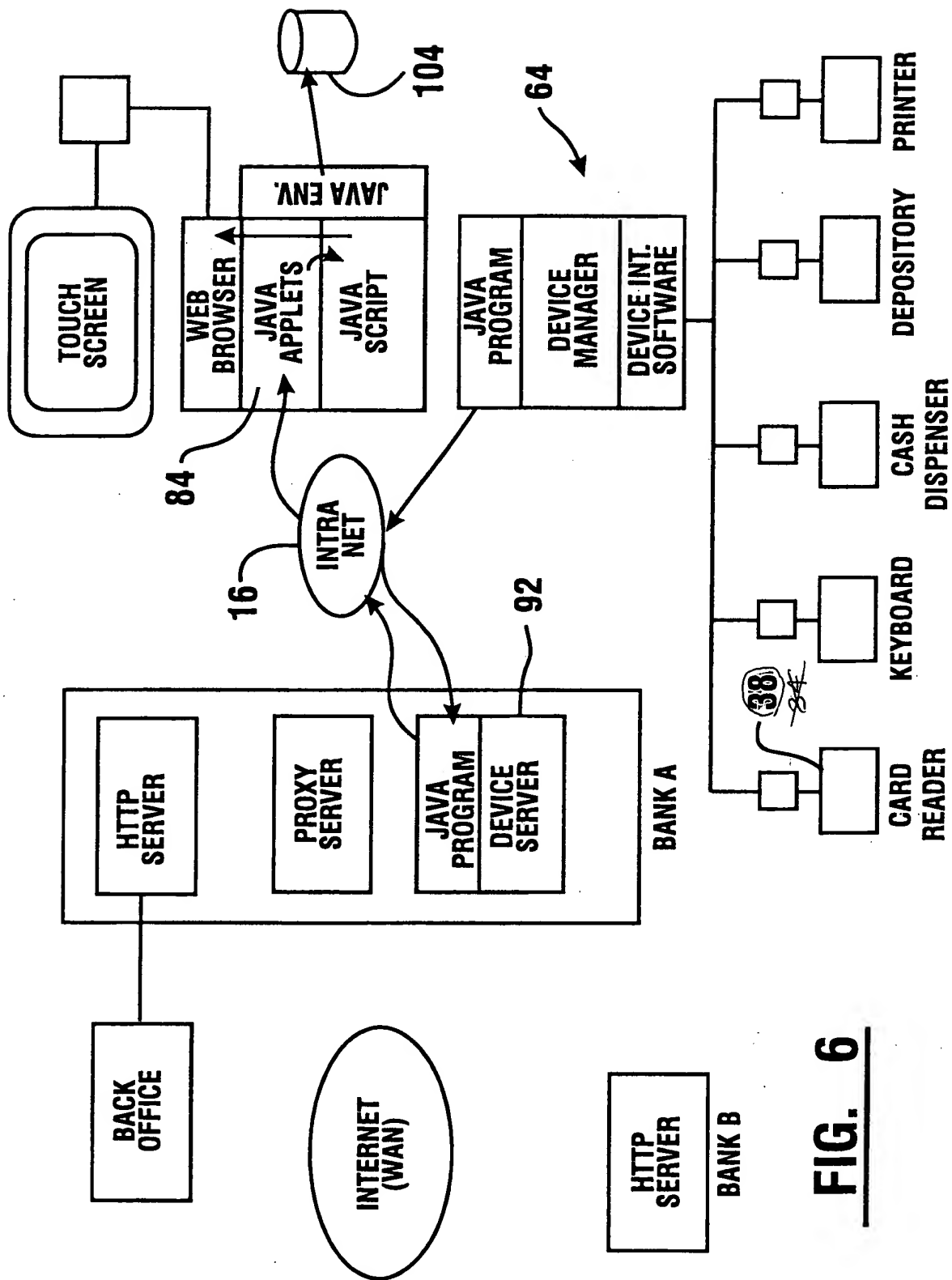
**FIG. 1**







**FIG. 5**



**FIG. 6**